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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,969	03/06/2002	Barry Nagle	2006.PGG	7562

7590

01/24/2005

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,969

Applicant(s)

NAGLE ET AL.

Examiner

David T. Fox

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1638

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendment of 12 November 2004 has obviated the indefiniteness rejection.

Claims 1-2, 4-5, 7-8 and 10-11 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to a method for making a maize plant which is homozygous/heterozygous for waxy/sugary2 or waxy/white endosperm, does not reasonably provide enablement for claims broadly drawn to a method of making a maize plant which is homozygous/heterozygous for waxy/horny or any other combination of waxy with a second triploid trait allele. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims, as stated on pages 2-5 of the last Office action.

The claims remain deemed free of the prior art, as stated on page 5 of the last Office action.

Claims 6 and 12 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as stated on page 5 of the last Office action.

Claims limited to waxy and white endosperm as the two kernel mutant traits to be used in the claimed method would also be deemed allowable, as stated on page 5 of the last Office action.

No claim is allowed.

Applicant's arguments filed 12 November 2004 have been fully considered but they are not persuasive. Applicant urges that the enablement rejection is improper, given the production of a variety of hybrids as demonstrated on page 9 of the specification (Example 3), the detailed description of the method of hybridization, and the irrelevance of inferior starch quality or quantity, pollen viability or seed set as asserted by the Examiner.

The Examiner maintains that the specification is silent with respect to the number of rows of each parent used to produce the plants outlined in Example 3, in contrast to the detailed disclosure of methods used to produce the plants in Examples 1 and 2. Furthermore, inferior starch quality, pollen viability or seed set are indeed quite germane to the enablement of the broad claims. If the starch produced by the corn plant is of inferior quality or quantity, then the specification has not taught how to use plants producing kernels containing said starch, other than for reproductive purposes or for animal feed. However, if the corn plants of the broadly claimed genotypes have poor pollen germinability or poor seed set, then few plants will be produced for either forage or reproductive purposes. In addition, poor pollen germinability or poor seed set will hinder the function of said plants as parents in the claimed hybridization method, and no guidance has been provided regarding the use of specific numbers of rows of each non-exemplified parental combination in order to overcome the hurdles presented by poor pollen germinability or seed set. Finally, if the corn plants produce starch with inferior

quality or quantity, there is no reason to reproduce them. Thus, the specification has not taught how to make and/or use all of the broadly claimed corn genotypes.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is 571-272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy J. Nelson, Ph.D., can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 20, 2005

DAVID T. FOX
PRIMARY EXAMINER
GROUP 160 1638

